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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in re patent application of:

) Date: January 25, 2006

Ronald P. Sansone

) Attorney Docket No.: E-986

Serial No.: 09/818,480

) Customer No.: 00919

Filed: March 27, 200

) Group Art Unit: 3629

Confirmation No.: 9576

) Examiner: Thomas A. Dixon

Title: **RECIPIENT ELECTED MESSAGING SERVICES FOR MAIL THAT IS
TRANSPORTED IN TRAYS OR TUBS**

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION 37 CFR 1.192)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith in **triplicate** is the **APPEAL BRIEF** in the above-identified patent application with respect to the Notice of Appeal filed on January 17, 2006.

Pursuant to 37 CFR 1.17(c), the fee for filing the Appeal Brief is \$500.00

Please charge Deposit Account No. **16-1885** in the amount of \$500.00 to cover the above fees.

The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. **16-1885**.

A duplicate copy of this transmittal is enclosed for use in charging the Deposit Account.

Respectfully submitted,

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Signature

Amy Harvey
Name of Person Certifying



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of:) Date: January 25, 2006
Ronald P. Sansone) Attorney Docket No.: E-986
Serial No.: 09/818,480) Customer No.: 00919
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Confirmation No.: 9576) Examiner: Thomas A. Dixon
Title: **RECIPIENT ELECTED MESSAGING SERVICES FOR MAIL THAT IS
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CORRECTED APPELLANT'S BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The appellants respectfully submit the following brief in the appeal of the subject application. The Notice of Appeal was filed on October 12, 2004, and the January 17, 2006, Notification of Non-Compliant Appeal Brief.

This brief is transmitted in triplicate.

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TABLE OF CONTENTS

I	REAL PARTY IN INTEREST
II	RELATED APPEALS AND INTERFERENCES
III	STATUS OF CLAIMS
IV	STATUS OF AMENDMENTS
V	SUMMARY OF CLAIMED SUBJECT MATTER
VI	GROUND OF REJECTION TO BE REVIEWED ON APPEAL
VII	ARGUMENT
VIII	APPENDIX OF CLAIMS INVOLVED IN THE APPEAL
IX	EVIDENCE APPENDIX
X.	RELATED PROCEEDING APPENDIX

I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

An Appeal to the USPTO Board of Appeals has been filed in copending U.S. Patent Application Serial No. 09/818,792 entitled "Recipient Elected Messaging Services" may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

- A.) Claims 1-34 are in the application.
- B.) Claims 1-34 are rejected.
- C.) Claims 1-34 are on appeal.

IV. Status of Amendments

An Amendment subsequent to the July 13, 2004, Final Rejection was filed on September 2, 2004. This Amendment was not entered.

V. Summary of Claimed Subject Matter

BACKGROUND

Ever since the numeric codification of streets and buildings received general acceptance, an individual's name and household postal address have been linked. The sender of a letter or package would deliver a letter or package to the post that had the correct recipient postal address, and the post would deliver the letter or package to the numeric

street address of the recipient of the letter or package. A correct recipient postal address for the delivery of the letter or package to the recipient included the name of the recipient; the street address of the recipient; the city and state of the recipient; and the zip code of the recipient. Thus, the correct recipient postal address is usually the actual location of the recipient.

Typically, it takes the post three to five days to deliver letters and/or packages to a recipient. Sometimes, recipients of letters and packages like to know what letters and packages they are going to receive before receiving them. For instance, if someone is going on a trip, he/she may want to receive his/her bills, e.g., credit card, electric, gas, oil, hospital, doctor, etc. before leaving on the trip so that he/she may pay the bills before a finance charge for late payment of the bill is applied to his/her account. Someone may also want to receive a package before going on a trip in order to take the contents of the package on the trip. The recipient may also want to delay delivery of a particular letter or package until returning from a trip. The reason for the foregoing may be that the recipient does not want to retrieve the letter or package at the post office or have the letter or package waiting at a vacant house..

B. APPELLANT'S CLAIMED INVENTION

1. Claim 1 relates to a method that enables a recipient to inform a carrier of the manner in which the recipient wants some or all of recipient's mail that is placed in trays or tubs by the sender and is transported in trays or tubs delivered. More particularly, claim 1 includes the following steps: scanning the name and physical address of the recipient and the sender of the mail after the mail has been sealed; capturing by the sender the name and physical address of the recipient and the sender in the form of an image; transmitting the image to a

data center where the image is processed by translating the image consisting of text and graphics to selected alphanumerics; translating the name and physical address of the recipient into an e-mail address; notifying the recipient of the expected delivery of the sealed mail and indicating the selected alphanumerics of the translated image; depositing with the carrier the sealed mail containing the recipient's name and physical address and the sender's name and address; notifying a data center by the recipient of the manner in which the recipient wants some or all of their mail delivered; notifying by the data center the carrier of the manner in which the recipient wants the mail delivered; and delivering by the carrier mail to the recipient in the manner specified by the recipient to the carrier.

Appellant's invention is a method that enables a receiver or receiver's agent (hereinafter "recipient") to obtain notification of the letters, flats and/or packages (mail) that is transported in trays or tubs, which the recipient is going to receive prior to the delivery of the mail. The recipient is then able to inform a post or courier, e.g., Federal Express[®], Airborne[®], United Parcel Service[®], DHL[®], etc., of the manner in which the recipient would like mail that is transported in trays or tubs delivered. The post and courier hereinafter will be referred to as "carrier". For instance, the recipient may want the mail physically delivered to their house faster or slower, or the mail physically redirected to the recipient's temporary address, or physically delivered to the recipient's agent, or physically delivered to the recipient's attorney, or physically returned to the mailer, or have the carrier open the physical mail and have the carrier e-mail or fax the contents of the mailpiece to the recipient and/or parties designated by the recipient. Appellant's claimed invention is shown in Fig. 2 and described in line 17 of page 5 to line 12 of page 10 of Appellants' Patent Application.

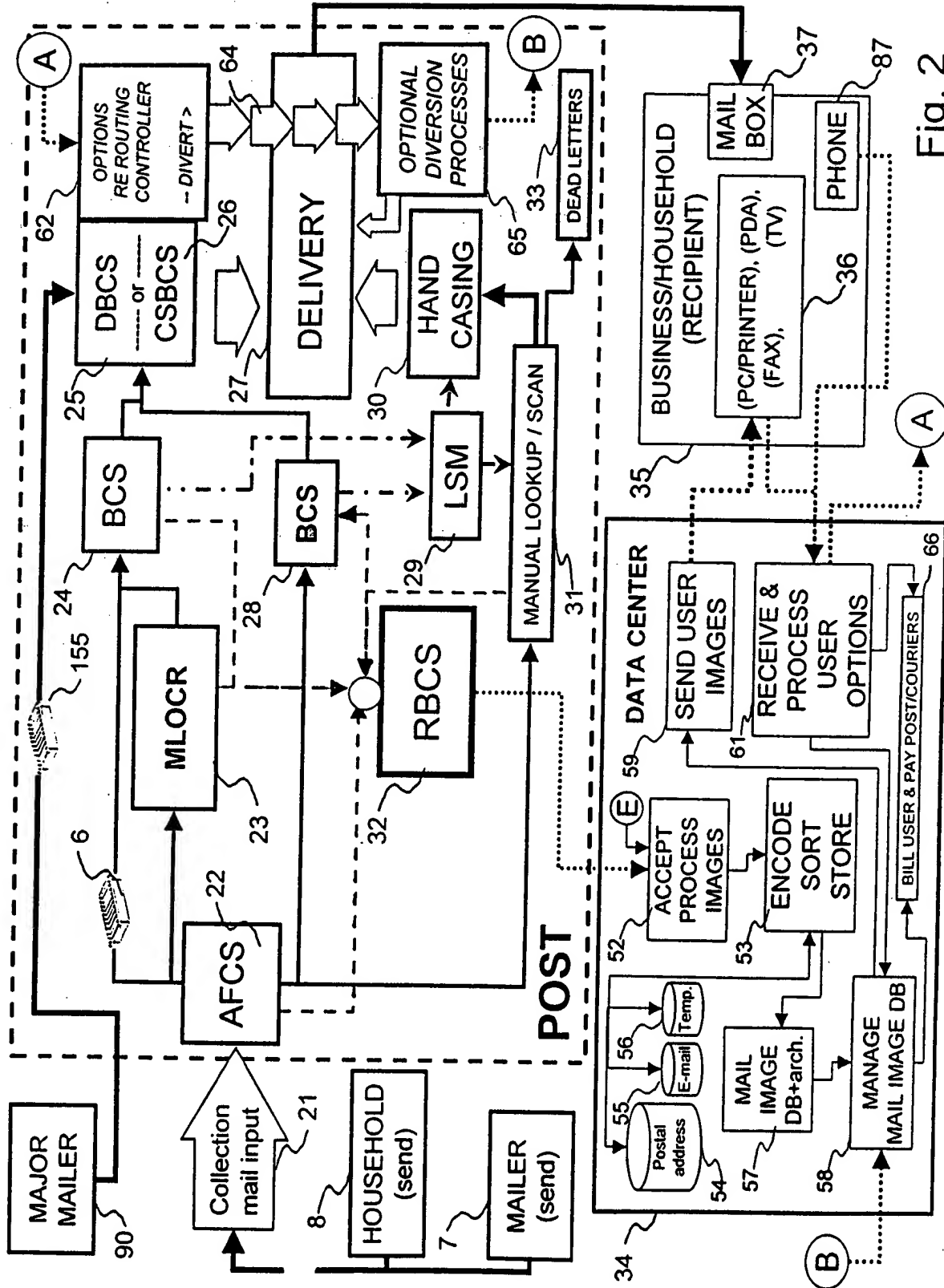


Fig. 2

A copy Fig.2 appears next to this page.

Fig. 2 is a drawing showing how this invention may be used by a post in the processing of letter mail. Letter mail that is deposited in trays 6 and delivered to the post is read by multiple line optical character reader (hereinafter "MLOCR") 23. Collection letter mail may be metered letter mail that is produced at a mailer site 7 or a sender household 8 by a postage meter or a personal computer meter, stamped mail, or permit mail. Collection letter mail is placed in collection mail input 21, e.g., mail boxes or delivered to the United States Postal Service unsorted. Collection letter mail is sent to advanced facer canceller (hereinafter "AFCS") 22. AFCS 22 first faces the letter mail. Then AFCS 22 electronically identifies and separates prebarcoded mail, handwritten addresses and machine-imprinted address pieces for faster processing through automation. Letter mail that AFCS 22 determines is optical character readable is sent to MLOCR 23. Reader 23 reads the entire address on the letter mail; sprays a bar code on the mail; and then sorts the mail. Letter mail that is able to be scanned and sorted by reader 23 is sent to bar code sorter/code printer 24. Letter mail that the mailer has prebarcoded and contains a facing identification mark is sent to bar code sorter/ code printer (hereinafter "BCS") 24.

Trayed mail 155 that is produced at a major mailer site 90 (Fig. 5) is sent to a delivery bar code sorter/code printer (hereinafter "DBCS") 25 or a carrier sequence bar code sorter/code printer (hereinafter "CSBCS") 26. An image of the face of the mailpieces in trayed mail 155 and the estimated time of arrival of each letter mailpiece in tray 155 are sent to accept process image 52. Sorters 25 and 26 sort the letter mail in the order that the mail is going to be delivered by postal carrier 27. Letter mail that AFCS 22 determines is not optical character readable is sent to bar code sorter/code printer (hereinafter "BCS") 28. Letter mail

that AFCS 22 obtains electronic images from and letter mail that reader 23 obtains electronic images from transfer the electronic images to remote bar code system (hereinafter "RBCS") 32. RBCS 32 matches the look up zip code for the letter mailpieces from AFCS 22 and merges them. System 32 electronically transmits the bar code information to BCS 28 where the bar code information is sprayed on the mailpieces. Letter mail that is able to be scanned and sorted by sorters 24 and 28 is sent to a DBCS 25. Sorters 25 and 26 sort the letter mail in the order that the mail is going to be delivered by postal carrier 27, or hold the mail for recipient diversion for a specified period of time in divert mail options rerouting controller 62.

Letter mail that can not be scanned and sorted by sorters 24 and 28 is sent to letter sort machine (hereinafter "LSM") 29. Letter mail that can be sorted by LSM 29 is sent to postal hand casing 30. Postal hand casing 30 is the process in which the postal carrier sorts the letter mail in the order that the letter mail is going to be delivered by postal carrier 27. Letter mail that can not be sorted by letter sort machine 29 is sent to manual process 31. Manual process 31 attempts to classify the previously rejected letter mailpiece to redirect the mailpiece, declare the mailpiece dead, or manually re-code the mailpiece for redelivery. Then the letter mailpieces that have not been processed in manual lookup, scan and sortation process 31 are sent to dead letters 33. In process 31, an operator may determine the address of the recipient and produce a label to be placed on the letter mail. Then the letter mail would go to postal hold casing 30 where the mail is sorted in the order that the mail is going to be delivered by postal carrier 27.

Letter mail that can not be faced and cancelled by AFCS 22 is sent to manual process 31. Manual process 31 attempts to classify the previously rejected letter mailpiece to redirect the mailpiece, declare the mailpiece dead, or manually re-code the mailpiece for redelivery.

Then the letter mail that manual process 31 is able to classify is sent to postal carrier casing 30 before it is delivered by postal carrier 27.

Coded video system 32 electronically transmits the bar code information that represents the destination of the letter mailpiece and the party to whom the mailpiece is to be delivered and the image of the face of the mailpiece to data center 34. The aforementioned scanners scan all of the information appearing on the face of the letter mail, e.g., (from Fig. 1A) the sender's name and address 12, the recipient's name and address 13, and postal indicia 14. The scanned information is transferred to accept process images 52. Then the information is sent to encode, sort, store 53. At this point, the recipient's physical address is verified by checking postal address data base 54, and the recipient's e-mail address is determined from e-mail data base 55. Temporary data base 56 is then searched to determine whether the recipient has left any forwarding addresses. Encode 53 then encodes and sorts the information obtained from data bases 54, 55 and 56.

The aforementioned encoded and sorted information is stored in mail image data base 57. Then the mail image information is sent to manage mail image 58 where the various options and the costs associated therewith that the recipient may have for delivering the information contained in the letter mail are determined. Then the mail images and options that the recipient has for receiving the letter mail are sent to images 59, where the information appearing on the face of the letter mail in alphanumeric and graphic form and the options in alphanumeric and graphic form the recipient has for receiving the letter mail are transmitted to receiving device 36 (personal computer, television, facsimile machine, personal data assistant, etc.), which is located at the recipient's business or household 35. The options that the recipient has for diverting the letter mail are described in the description of Fig. 4.

The recipient may use device 36 (personal computer, facsimile machine, personal data assistant, etc.) located at the recipient's business or household 35 to inform receive and process recipient options 61, located at data center 34, of the manner in which the letter mail should be delivered. The recipient may also use a touch tone and/or voice telephone 87 to inform options 61 of the manner in which the recipient would like the letter mail displayed on the receiving device 36, e.g., television delivered. For instance, the recipient may want the letter mail physically delivered to the recipient's house faster or slower, or the letter mail physically redirected to the recipient's temporary address, or physically delivered to the recipient's agent, or physically delivered to the recipient's attorney, or physically returned to the mailer, or have the post open the letter mail and have the post e-mail or fax the contents of the letter mail to the recipient and/or parties designated by the recipient.

At this juncture, the recipient may inform options 61 via a device 36 of the manner in which the recipient would like the letter mail processed. Options 61 will then inform the recipient via device 36 of the cost to the recipient to process the letter mail in the manner selected by the recipient. The recipient may then inform the post to deliver the letter mail in the manner selected by the recipient. The recipient's selected manner of letter mail processing is forwarded to options rerouting controller 62. If the post's specified time to deliver the letter mail has not been reached, the letter mail is sent to recipient options 64 and delivered in the manner selected by the recipient in route mail options 65. Then options 65 informs manage mail data base 58 to archive the image and also to notify bill sender and pay carriers 66 to bill the recipient and pay the post. At this point, the next letter mail image is ready to be processed.

The letter mail may then be delivered to the recipient at mail box 37 at a faster or slower rate than that selected by the sender; held by the post for a specified amount of time and then delivered to an address specified by the recipient; opened, and the contents of the letter mail faxed to recipient selected fax numbers; opened, and the contents of the letter mail faxed to recipient selected fax numbers, and then the letter mail may be delivered to the physical address specified by the recipient; opened, and the contents of the letter mail e-mailed to recipient's selected e-mail addresses; or, opened, and the contents of the letter mail e-mailed to recipient's selected e-mail addresses, and then the letter mail may be delivered to the physical address specified by the recipient. The recipient may also have instructed the post to return the mail to the sender, to destroy the mail, or to recycle the paper in the letter mail. Options 61 will also send the cost of the recipient's selected manner of delivery to bill recipient 66 so that data center 34 may inform the post to debit the recipient's account or send a bill to the recipient.

2. Claims 2 – 12 are discussed as items 2A – 2D below.

2A. Claims 2 - 4 depend on claim 1 and relates to notification of the recipient or carrier.

2B. Claim 5 depends on claim 4, which depends on claim 1, which relate to the recipient notifying the carrier to open the mail. Claims 6 - 9 depends on claim 4, which depends on claim 1. Claims 6 and 9 relate to informing the carrier to extract the contents of the mailpiece to one or more addresses; and mailing by other than physical mail the information included in contents of the mailpiece to the specified addresses.

2C. Claims 7 – 9 depend on claim 4 and relate to the recipient's notification of the carrier to open the mail and the carrier sending the recipient information contained in the mailing.

2D. Claims 10 –12 depend on claim 1 and relate to the time the mail is delivered.

The above features of Appellant's claimed invention discussed as items 2A – 2D above are described on lines 5 – 10 of page 9 of Appellant's Patent Application, which read as follows. "For instance, the recipient may want the letter mail physically delivered to the recipient's house faster or slower, or the letter mail physically redirected to the recipient's temporary address, or physically delivered to the recipient's agent, or physically delivered to the recipient's attorney, or physically returned to the mailer, or have the post open the letter mail and have the post e-mail or fax the contents of the letter mail to the recipient and/or parties designated by the recipient."

3. Claims 13 – 15 depend on claim 1 which relate to charging the recipient for the request service. The above features of Appellant's claimed invention is described on lines 11 – 20 of page 9 of Appellant's Patent Application, which read as follows.

"At this juncture, the recipient may inform options 61 via a device 36 of the manner in which the recipient would like the letter mail processed. Options 61 will then inform the recipient via device 36 of the cost to the recipient to process the letter mail in the manner selected by the recipient. The recipient may then inform the post to deliver the letter mail in the manner selected by the recipient. The recipient's selected manner of letter mail processing is forwarded to options rerouting controller 62. If the post's specified time to deliver the letter mail has not been reached, the letter mail is sent to recipient options 64 and delivered in the manner selected by the recipient in route mail options 65. Then options 65 informs manage mail data base 58 to archive the image and also to notify bill sender and pay carriers 66 to bill the recipient and pay the post."

4. Claims 16 – 27 depend on claim 1 which relate to the recipient notifying the carrier in the handling of the mail. The above features of Appellant's claimed invention is

described on line 22 of page 9 to line 12 of page 10 of Appellant's Patent Application, which read as follows.

"The letter mail may then be delivered to the recipient at mail box 37 at a faster or slower rate than that selected by the sender; held by the post for a specified amount of time and then delivered to an address specified by the recipient; opened, and the contents of the letter mail faxed to recipient selected fax numbers; opened, and the contents of the letter mail faxed to recipient selected fax numbers, and then the letter mail may be delivered to the physical address specified by the recipient; opened, and the contents of the letter mail e-mailed to recipient's selected e-mail addresses; or, opened, and the contents of the letter mail e-mailed to recipient's selected e-mail addresses, and then the letter mail may be delivered to the physical address specified by the recipient. The recipient may also have instructed the post to return the mail to the sender, to destroy the mail, or to recycle the paper in the letter mail. Options 61 will also send the cost of the recipient's selected manner of delivery to bill recipient 66 so that data center 34 may inform the post to debit the recipient's account or send a bill to the recipient."

5. Claims 28 – 34 depend on claim 1 which relate to placing a graphic on the mail. The above features of Appellant's claimed invention, is described on lines 2 - 16 of page 5 of Appellant's Patent Application, which read as follows.

"Referring now to the drawings in detail and more particularly to Fig. 1A, the reference character 11 represents a mailpiece that has a sender address field 12, a recipient address field 13 and a postal indicia 14.

Fig. 1B is a drawing of a permit mailpiece. Mailpiece 15 has a sender address field 16, a recipient address field 17 and a permit 18.

Fig. 1C is a drawing of a stamped mailpiece. Mailpiece 19 has a sender address field 20, a recipient address field 9 and a stamp 10.

Fig. 1D is a drawing of a flat or package that is going to be delivered by a carrier. Package 40 has a label 39 affixed thereto. Label 39 has a sender address field 41, a recipient address field 42 and may have other sender information, e.g., the senders phone number 44. Indicia 43 is affixed to label 39. Indicia 43 may be a postal indicia or courier symbology.

Figs. 1A-1D show various methods of evidence for the payment of postage. It will be obvious to one skilled in the art that additional methods of evidence for the payment of postage exist."

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether or not claims 1-4, 7, 10-12, 13, 18, 20, 24 and 28 - 34 are patentable under 35 USC §103(a) over Smith, et al. (U.S. 2002/0095306A1 or U.S. 2002/0042808A1) in view of Higgins, et al. (U.S. 5,754,671).

B. Whether or not claims 5, 8-9, 13-15, 19, 21 – 23, 25 and 26 are patentable under 35 USC §103(a) over Smith, et al. (U.S. 2002/0095306A1 or U.S. 2002/0042808A1) in view of Higgins, et al. (U.S. 5,754,671).

(i) VII. ARGUMENTS

A. Claims 1-3, 12, 13, 17 – 19, 21, 25 and 28 – 35 have been rejected by the Examiner under 35 U.S.C. 103(a) over Smith, et al. (U.S. 2002/0095306A1 or U.S. 2002/0042808A1) in view of Higgins, et al. (U.S. 5,754,671).

Smith discloses the following in paragraph [0022] and [0023] of patent application 0042808:

"[0022] **FIG. 9** shows a screen **130** that enables the user to configure preferences for delivery. Column **132** contains icons **132a**, **132b**, **132c** identifying data objects comprising, e.g., first class mail (**132a**), parcels (**132b**), and periodicals (**132c**), respectively; other types of data objects may, of course, be included. Columns **134**, **136**, **138**, and **140**, respectively, identify sites or addresses to which the objects of a given object class are to be redirected. For example, column **134** contains "home" icons that identify the home address of the user as the site to which the object is to be directed or redirected; column **136** contains "locker" icons that specify a facility (e.g., a "lockbox") to which the object is to be directed or redirected; and column **138** contains "hold at PO" icons that identify the user's Post Office as the site to which the objects are to be directed or redirected. (For simplicity, hereinafter the terms "direction" or "directed" will be used to indicate

either the initial selection of a delivery location ("direction"), or a subsequent change in this location ("redirection"), or both).

[0023] Column **140** allows the user to enter a specific address that may differ from one of the preset addresses of columns **134-138**. For example, a home address may previously have been set for delivery of mail of all types. When the user is about to go on a business trip, for example, he or she may desire to have first class mail forwarded to the address of a hotel at which he or she will be staying until his or her return; to have parcels held in a locker and to have periodicals held at the local Post Office. This is accomplished simply by clicking on the "Enter New Address" icon in column **140** in the "First Class" mail row **132a** and by entering the address of the hotel; by clicking on the "Locker" icon in column **136** in the "Parcels" mail row **132b**; and by clicking on the "Periodicals" icon in column **138** in the "Periodicals" mail row **132c**. The chosen preferences are desirably then indicated by a checkmark or other indicia, as shown in **FIG. 9**. These preferences may remain until subsequently changed, or may default to a user-defined configuration after a certain time period; or a sequence of addresses and associated time periods may be provided for the various data objects.

Smith discloses the following in paragraphs [0053] and [0054] of Patent Application 0095306:

"[0053] If the user continues the session, the Postport system retains the relevant postal transaction session information in a manner that is linked to the user's assigned user ID, as discussed below. When the user later logs on to the Postport system from, for example, a terminal **188** at the postal station **176** using the assigned user ID, the system transfers the session to the terminal. The user then continues to enter and/or edit the mailing address and postage information and/or print the labels and the postage before ending the session.

[0054] The session transfer may be facilitated by assigning to a given user a coded physical identification token, such as a key fob **200** with a User ID included as a machine-readable barcode **201** (**FIG. 11**). The user presents his or her physical identification token to a scanner that is connected to the system through, for example, the work station node **180**. The system then prompts the user to supply his or her password and, after verification of the password, the system transfers the linked messages and thus the session to the terminal then in use. As discussed in more detail below, the system may also transfer the linked messages to the various other terminals in the same postal station, such that the user can readily transfer the session to another terminal that is connected to a printer, a postage meter, and so forth, by logging on using the assigned user ID. The user may thus take full advantage of the Postport system's virtual post office services, even if he or she does not have the appropriate hardware and/or software to print the labels and postage."

Higgins discloses the following in column 4, line 34 to column 5, line 11:

"In determining the correct zip code it is important to note that the quality of the address interpretation depends on the success of the previous steps. Without the correct ABL, good segmentation and reasonable character recognition, there is little hope of finding the correct zip.

In order for the correct zip to be found, the following conditions have to be met. The correct candidate ABL has to be used. The number of characters in the word containing the zip has to clearly indicate that this word contains the zip code. That is, segmentation must recognize the word breaks around the zip code, which is quite difficult for hand images due to inconsistencies in handwriting. The characters have to be segmented correctly. Errors in character segmentation such as splitting a character into two separate characters or combining two characters as one, preclude the possibility of good character recognition and, hence, address interpretation. Character recognition must produce the correct character. The confidence of the correct characters have to be good. This is not as important as having the correct character recognized, but it does allow more decisions on zip codes to be finalized.

An example of an image **64** passed through this conventional process of address block location segmentations, character recognition and address interpretation indicated by reference number **65** is shown in FIG. 5. In this illustrative example, a case where the address interpretation process could not make a determination due to the inaccurately recognized digit (13821 versus 13827).

Since 13821 is not a valid zip code, as can be verified with a database search, a bar code will not be assigned and so manual processing is required. It will be shown, hereinafter, how adaptive signal processing, in accordance with the present invention, was successfully applied to this problem."

In this example, the zip code has been recognized incorrectly and so the database search does not yield an exact match. Rather than assigning a potentially incorrect bar code.

Neither Smith nor Higgins, taken separately or together, discloses or anticipates the steps of claim 1, namely, capturing by the sender the name and physical address of the recipient and the sender in the form of an image; transmitting the image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumeric; translating the name and physical address of the recipient into an e-

mail address; and notifying the recipient of the expected delivery of the sealed mail and indicating the selected alphanumerics of the translated image.

Higgins discloses a method for the cursive address recognition of mail pieces. In Smith, the recipient is not notified of the expected delivery of the sealed mail while indicating the selected alphanumerics of the translated image. Smith also requires that the (sender) user print a user ID included as a machine-readable barcode 201 so as to capture the identity of each mailpiece during the inbound postal tracking process, to enable accurate data message linkage prior to the physical delivery of the mail piece to the (recipient) user.

Appellant does not claim a method in which a sender printed personal ID code is added to each mail piece, and the ID code is captured by the post. Appellant claims a method in which the sender captures the name and physical address of the recipient and sender in the form of an image and the translation of the name and physical address of the recipient into an e-mail address.

Furthermore, Smith requires this same ID code be associated (added) to any other postal data object (MESSAGE, etc.) so that it can be later associated (LINKED) at the mail piece recipient's computer display. Smith does not resolve how he can produce the accurate metering of more than one such data objects for a sender that submits more than one mail piece with the same personal ID code into the postal system on the same day.

Notwithstanding the foregoing, in rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *in re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *in re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having

ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *in re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *in re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, *supra*; *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *in re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

B. Claims 5, 8-9, 13-15, 19, 21 – 23, 25 and 26 have been rejected by the Examiner under 35 U.S.C. 103(a) over Smith, et al. (U.S. 2002/0095306A1 or U.S. 2002/0042808A1) in view of Higgins, et al. (U.S. 5,754,671).

The Examiner stated on page 7 of the July 13, 2004, Final Rejection:

"However, the modified Smith et al. does not specifically disclose the method including the limitations in Claims 5, 8-9, 13-15, 19, 21-23 and 25-26 (opening the mail, sending the information contents to PDA, using facsimile, how to charge, recycling the mail, telephoning, and notifying via television).

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to arrange to open the mail, sending the information contents to PDA, notify via a facsimile, telephone or television, charge the recipient for the service and recycle the mail because Applicant has not disclosed that the above claimed limitations provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified method of Smith et al. because one of ordinary skill in the art may adopt other notification manners and incorporate them into the modified notification system of Smith et al...

Therefore, it would have been an obvious matter of design choice to further modify the modified invention of Smith et al. in view of Higgins et al. so as to obtain the invention as specified in claims 5, 8-9, 13-15, 19, 21-23 and 25-26."

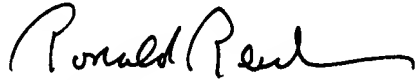
Claims 5, 8-9, 13-15, 19, 21 – 23, 25 and 26 depend on claim 1 or claims that depend on claim 1. In addition to the arguments made in above Section A, the Examiner has not cited any art to indicate why it would be obvious to send the contents of the mailpiece via different specified channels in the environment of claim 1.

The limitations of the above claims provide an advantage to a sender of physical mail in that the sender is able to allow the recipient to receive the contents of the physical mail in the media of the recipient's choice. Thus, the recipient is more likely to respond to the message contained in the mailpiece. This is particularly important in the case of advertising mail where the recipient will be more likely to purchase something. The limitations of the above claims also provide an advantage to a recipient of physical mail in that the recipient is able to receive the information in the media of their choice.

Appellant respectfully submits that appealed claims 1 – 34 in this application are patentable. It is requested that the Board of Appeal overrule the Examiner and direct allowance of the rejected claims.

In conclusion, Appellant respectfully submits that the final rejection of claims 1 and 7 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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VIII. Claims Appendix A

1. A method that enables a recipient to inform a carrier of the manner in which the recipient wants some or all of their mail that is placed in trays or tubs by the sender and is transported in trays or tubs delivered, said method comprises the steps of:

scanning the name and physical address of the recipient and the sender of the mail after the mail has been sealed;

capturing by the sender the name and physical address of the recipient and the sender in the form of an image;

transmitting the image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumerics;

translating the name and physical address of the recipient into an e-mail address;

notifying the recipient of the expected delivery of the sealed mail and indicating the selected alphanumerics of the translated image;

depositing with the carrier the sealed mail containing the recipient's name and physical address and the sender's name and address;

notifying a data center by the recipient of the manner in which the recipient wants some or all of their mail delivered;

notifying by the data center the carrier of the manner in which the recipient wants the mail delivered; and

delivering by the carrier mail to the recipient in the manner specified by the recipient to the carrier.

2. The method claimed in claim 1, wherein the recipient is notified of the estimated time in which the mail is going to be delivered.

3. The method claimed in claim 1, wherein the recipient notifies the carrier to deliver the mail to a specified name and address.

4. The method claimed in claim 1, wherein the recipient notifies the carrier to return the mail to the sender.

5. The method claimed in claim 1, wherein the recipient notifies the carrier to open the mail.

6. The method claimed in claim 4, further including the steps of:

informing the carrier to e-mail the contents of the mailpiece to the recipient; and
mailing by e-mail the contents of the mailpiece to the recipient.

7. The method claimed in claim 4, further including the steps of:

informing the carrier to e-mail the contents of the mailpiece to one or more specified e-mail addresses; and

mailing by e-mail the contents of the mailpiece to the specified e-mail addresses.

8. The method claimed in claim 4, further including the steps of:

informing the carrier to send by facsimile the contents of the mailpiece to the recipient; and

mailing by facsimile the contents of the mailpiece to the recipient.

9. The method claimed in claim 4, further including the steps of:

informing the carrier to facsimile the contents of the mailpiece to one or more specified facsimile numbers; and

sending by facsimile the contents of the mailpiece to the specified facsimile numbers.

10. The method claimed in claim 1, wherein the recipient notifies the carrier to deliver the mail to the recipient at a different address.

11. The method claimed in claim 1, wherein the recipient notifies the carrier to deliver the mail to the recipient by a slower delivery method than that paid for by the sender.

12. The method claimed in claim 1, wherein the recipient notifies the carrier to deliver the mail to the recipient by a faster delivery method than that paid for by the sender.

13. The method claimed in claim 1, further including the step of:
charging the recipient for receiving notification of the availability of the deposited mail.

14. The method claimed in claim 1, further including the step of:
charging the recipient for delivering mail to the recipient in the manner specified by the recipient to the carrier.

15. The method claimed in claim 1, further including the step of:
charging the recipient for receiving notification of the availability of the deposited mail; and
charging the recipient for delivering mail to the recipient in the manner specified by the recipient to the carrier.

16. The method claimed in claim 1, further including the step of:
informing the sender of the delivery of the mail.

17. The method claimed in claim 1, wherein the recipient notifies the carrier to hold the mail for a specified period of time.

18. The method claimed in claim 1, wherein the recipient notifies the carrier to destroy the mail.

19. The method claimed in claim 1, wherein the recipient notifies the carrier to recycle the material comprising the mail.

20. The method claimed in claim 1, wherein the recipient is notified via e-mail of the availability of the deposited mail.

21. The method claimed in claim 1, wherein the recipient is notified via telephone of the availability of the deposited mail.

22. The method claimed in claim 1, wherein the recipient is notified via facsimile of the availability of the deposited mail.

23. The method claimed in claim 1, wherein the recipient is notified via television of the availability of the deposited mail.

24. The method claimed in claim 1, wherein the carrier is notified via e-mail of the manner in which the recipient wants the mail delivered.

25. The method claimed in claim 1, wherein the carrier is notified via facsimile of the manner in which the recipient wants the mail delivered.

26. The method claimed in claim 1, wherein the carrier is notified via telephone of the manner in which the recipient wants the mail delivered.

27. The method claimed in claim 1, wherein the recipient notifies a data center who notifies the carrier of the manner in which the recipient wants the mail delivered.

28. The method claimed in claim 1, wherein the mail deposited with the carrier contains a graphic.

29. The method claimed in claim 28, wherein the graphic is a stamp.

30. The method claimed in claim 28, wherein the graphic is a postal indicia.

31. The method claimed in claim 28, wherein the graphic is a permit.

32. The method claimed in claim 28, wherein the graphic is carrier symbology.

33. The method claimed in claim 28, wherein the graphic is captured and translated.

34. The method claimed in claim 33, wherein the graphic is stored.

IX. EVIDENCE APPENDIX

There is no additional evidence to submit.

X. RELATED PROCEEDING APPENDIX

An Appeal to the USPTO Board of Appeals has been filed in copending U.S. Patent Application Serial No. 09/818,792 entitled "Recipient Elexcted Messaging Services" may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

An Appeal to the USPTO Board of Appeals has been filed in Copending U.S. Patent Application Serial No. 09/817,998 entitled "MESSAGING SERVICES FOR THE VIAUALLY IMPAIRED" may directly affect or be directly affected or have a bearing on the Board's decision in this appeal.